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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 11/16/2005

Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
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EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/771,054	Applicant(s) MALLO ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>11/08/05</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Examiner acknowledges receipt of request for reconsideration and remarks filed 09/30/05.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action, on the basis that a new use for an old product is patentable, is persuasive and, therefore, the finality of that action is withdrawn.
2. A telephone call placed to applicants' attorney to discuss amendment to the pending claims that may place the claims in condition for allowance was not successful.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 29-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733) and Gaa et al. (US 4,567,228) in view of de la Poterie et al. (5,972,354).

Chang teaches dispersions of poly (urethane-urea) terminated by hydrolysable or hydrolyzed silyl groups (abstract). The dispersion further comprises solubilizing groups, which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds (column 3, lines 1-6). Isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. X₃si-compound, ethylene glycol polyfunctional chain extender, and water solubilizing compound react to form polyurethane-urea dispersions in water (column 3, line 14 to column 4, line 4 and column 6, lines 26-31). Terminal silyl groups are listed in column 7, lines 11-25 and all but one are clearly the silyl groups recited in claim 7 of the instant

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invention. Ammonium carboxylates are disclosed as water-soluble thermoplastic compounds (column 7, lines 49-65). Chang's composition is a coating composition.

Gaa discloses a coating composition that comprises polyurethane urea that is functionalized with silyl group and pigments, surfactants, plasticizers, antioxidants, fillers or other additives.

A combination of Gaa and Chang is a coating composition that comprises polyurethane urea with silyl groups, pigment, solubilizing groups, which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds, isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. $X_3\text{Si}$ -compound, ethylene glycol polyfunctional chain extender. The combination of Gaa and Chang is *prima facie* according to *in re Kerkhoven*. However, the composition is used as a coating composition. The composition is not used in the method of the instant claims as a cosmetic composition.

The composition used in the method of the instant claims is a known composition as discussed above for Chang and Gaa. However, the combined composition of Gaa and Chang is not used in the method of the instant claims. It is known in the art that polyurethane-urea – containing-compositions have utility in cosmetics. For example, de la Poterie discloses a method of making up, protecting, or treating the skin, semimucosae or mucosae by applying to the skin a composition comprising film forming polymer such as polyurea/polyurethane (claims 1, 4, 9 and 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two compositions of Gaa and Chang to make a third composition for use as a coating composition. One having ordinary skill in the art would have

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been motivated to use the combined composition of Gaa and Chang as a cosmetic since polyurea/polyurethane containing compositions are used as cosmetic in a method of making up, protecting, or treating the skin, semimucosae or mucosae according de la Poterie.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

